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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,382	05/31/2005	Koji Sugiyama	121284	5076

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EXAMINER

MCCLAIN, GERALD

ART UNIT	PAPER NUMBER
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3653

MAIL DATE	DELIVERY MODE
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01/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/509,382	SUGIYAMA ET AL.	
	Examiner	Art Unit	
	GERALD W. MCCLAIN	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-12 and 16-17, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent 48-104334 ("JP48") in view of Fujiwara (WO 200189957 A1). JP48 discloses:

Claims 1 and 16: printer (title; Note: since JP48 is a copier, there is inherently a printer portion.); package member (1); sheet package (1); flap member (3; Note: 3 is *capable of* covering the sheets when closed since (a) 3 covers a portion of the sheets as shown in figure 2, or (b) part 5 is *capable of* being placed over the sheets to completely cover the sheets up. Regarding the Claim 16 (and 17), see MPEP § 2115, "Material Or Article Worked Upon Does Not Limit Apparatus Claims");

Claim 2: flap member (3); portion of the package member (3);

Claim 3: package member (1); portion (3); prescribed part (5);

Claim 4: package member (1); tongue part (See figure 4 below, A); portion of the package member (3); pressing member (11); roller (13); printer (title);

Claim 5: package member (1); first cut (See figure 2 below, B); portion of the package member (3); (Note: 3 "can be engaged" with B since 5 is *capable of* moving up or attaching to 3 at B.)

Art Unit: 3653

Claim 6: package member (1); second cut (See figure 2 below, C); portion of the package member (3); (Note: 3 "can be engaged" with C since 5 *is capable of* moving up or attaching to 3 at C.)

Claim 7: second cut (C); tongue part (A);

Claim 8: package member (1); sheet packages (1); part of the package member (5); first cut (B); (Note: one configuration of a plurality of sheet packages is the following: two sheet packages facing each other with 5 cut off at B and C *can be* connected together in an aligned state by having 5 halfway inserted into both sheet packages. Other configurations are possible.)

Claim 9: package member (1); wrapping part (See figure 2 below, D); part of an outside of the tongue part (See figure 2 below, G); tab (5); (Note: 5 *can be* used to remove 1 from the printer with adhesive or some other mechanism between 1 and 5.)

Claims 10 and 17: printer (title); package member (1); sheet package (1); base (1 on the 11 side); flap part (3); tongue part (See figure 4 below, A); first wrapping part (See figure 2 below, D); second wrapping part (opposed to D);

Claim 11: crease (See figure 4 below, H); flap part (3); base (1 on the 11 side); package member (1); flap part (3);

Claim 12: tongue part (A); base (1 on the 11 side); flap part (3).

JP48 does not directly show a fastening member.

Fujiwara shows a similar device having a fastening member (paragraph [0064], "tape") for the purpose of protecting the sheets while sheets are being stored or fed right up until the sheets are set in a printer (paragraph [0014]). Therefore, it would have been

Art Unit: 3653

obvious to a person having ordinary skill in the art at the time the invention to modify JP48 as taught by Fujiwara and include Fujiwara's similar device having a fastening member for the purpose of protecting the sheets while sheets are being stored or fed right up until the sheets are set in a printer.

Claims 1-11 and 16-17, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Medoff (US 1,883,852) in view of Fujiwara. Medoff discloses:

Claims 1 and 16: package member (See Fig. 3, 1); sheet package (1); flap member (See Fig. 5, 7); (Note: the *intended use* of the *sheet package* is for setting it in a printer. The sheet package of Medoff is *capable of* being set in a printer. Regarding the Claim 16 (and 17), see MPEP § 2115, "Material Or Article Worked Upon Does Not Limit Apparatus Claims")

Claim 2: flap member (7); portion of the package member (7);

Claim 3: package member (1); portion (7); prescribed part (not shown; material surrounding 7);

Claim 4: package member (1); tongue part (See Fig. 3 (*not* Fig. 5), 7); portion of the package member (See Fig. 5, 7); (Note: the *intended use* of the *sheet package* is for setting it in a printer with a pressing member and roller. The sheet package of Medoff is *capable of* being set in a printer with a pressing member and roller.)

Art Unit: 3653

Claim 5: package member (1); first cut (8); portion of the package member (See Fig. 5, 7);

Claim 8: package member (1); sheet packages (1); part of the package member (See Fig. 5, 7); first cut (8); (Note: one configuration of a plurality of sheet packages is the following: two sheet packages (Fig. 1) facing each other *can be* connected together in an aligned state by having 7 (Fig. 3) inserted into 8 of the other sheet package. Other configurations are possible.)

Claim 9: package member (1); wrapping part (3); part of an outside of the tongue part (2); tab (See Fig. 5 below, J);

Claims 10 and 17: package member (See Fig. 3, 1); sheet package (1); base (5); flap part (See Fig. 5, 7); tongue part (See Fig. 3 (*not* Fig. 5), 7); first wrapping part (3); second wrapping part (3); (Note: the *intended use* of the *sheet package* is for setting it in a printer. The sheet package of Medoff is *capable of* being set in a printer.)

Claim 11: crease (See Fig. 5, 2); flap part (See Fig. 5, 7); base (5); package member (1); flap part (See Fig. 5, 7).

Medoff does not directly show a fastening member.

Fujiwara shows a similar device having a fastening member (paragraph [0064], "tape") for the purpose of protecting the sheets while sheets are being stored or fed right up until the sheets are set in a printer (paragraph [0014]). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify Medoff as taught by Fujiwara and include Fujiwara's similar device having a fastening

Art Unit: 3653

member for the purpose of protecting the sheets while sheets are being stored or fed right up until the sheets are set in a printer.

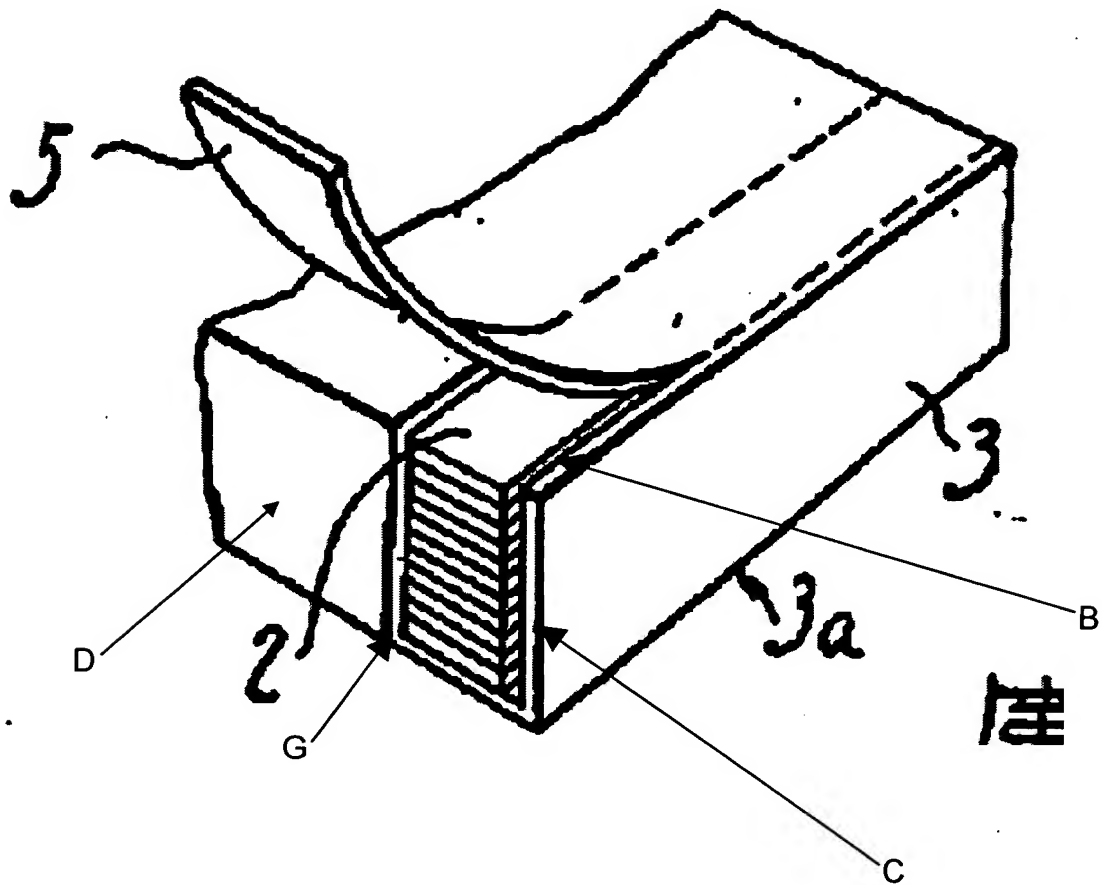
Claim 15, as understood by the Examiner, is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishiduka, et al. (US 6,217,019) ("Ishiduka") in view of Fujiwara. Ishiduka discloses:

Claim 15: printer (column 1, line 7); package member (20); recloseable flap member (20d/20e); indicator part (29a); window of the printer (44; Note: 35 is part of the printer); joining part (20g).

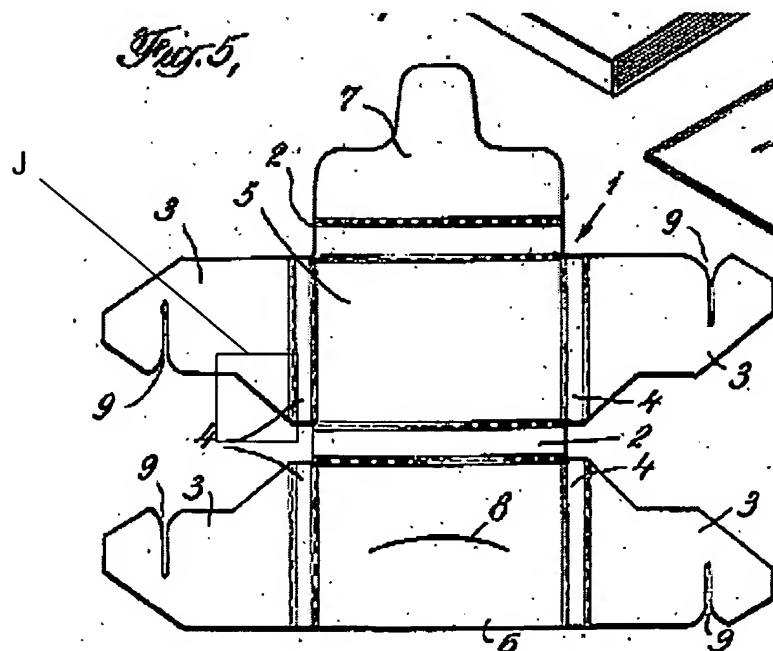
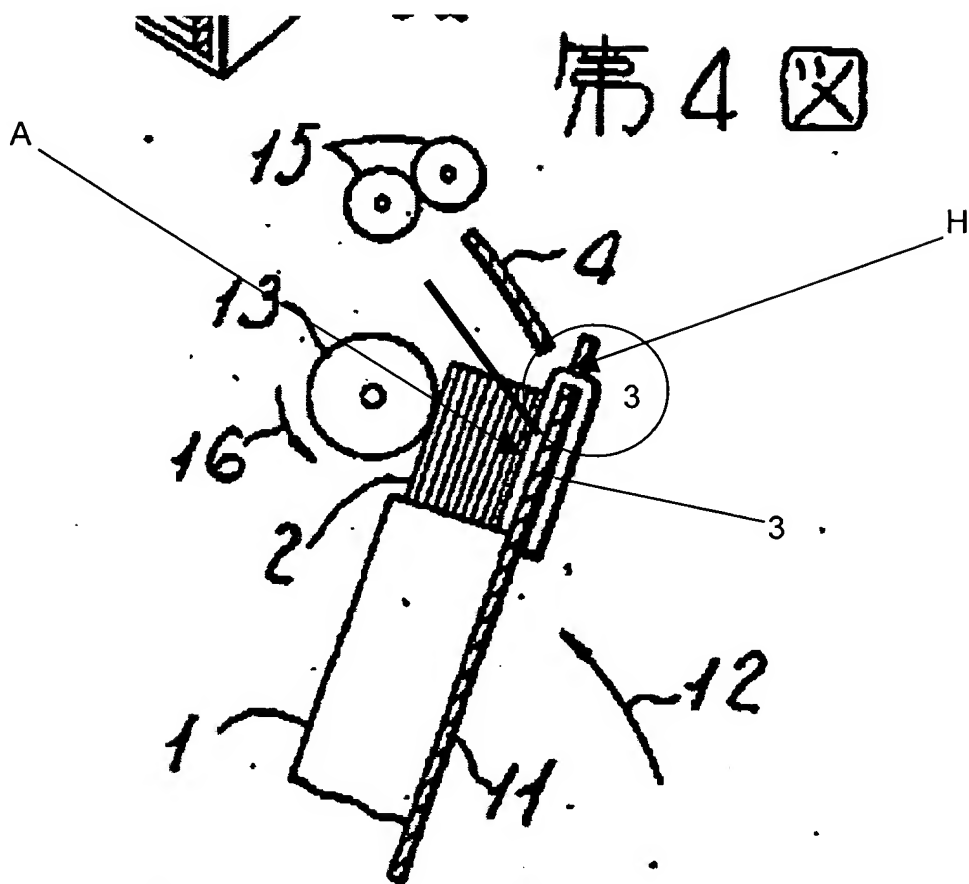
Ishiduka does not directly show a fastening member.

Fujiwara shows a similar device having a fastening member (paragraph [0064], "tape") for the purpose of protecting the sheets while sheets are being stored or fed right up until the sheets are set in a printer (paragraph [0014]). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify Ishiduka as taught by Fujiwara and include Fujiwara's similar device having a fastening member for the purpose of protecting the sheets while sheets are being stored or fed right up until the sheets are set in a printer.

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Art Unit: 3653



Art Unit: 3653

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Medoff in view of Fujiwara. Medoff and Fujiwara disclose all the limitations of the claims as discussed above. Medoff does not directly show a base that is provided with a cut into which the flap part is inserted to be fixed in the opened state. Medoff has disclosed that the base is provided with a cut into which the flap part is inserted in order to be fixed in the opened state. It would be obvious to one of ordinary skill in the art to modify Medoff to have a cut provided in the base for the flap part in the opened state for the purpose of eliminating the need for adhesive. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP48 in view of Fujiwara and further in view of Medoff. JP48 and Fujiwara disclose all the limitations of the claims as discussed above. JP48 does not directly show a tongue part (See figure 4 above, A of JP48) provided with a cut into which the flap part (3 of JP48; See figure 4 above for all parts of 3.) is inserted to be fixed in the closed state (See Claim 1. Note: the closed state does not require the *entire* exposed part of the sheets to be covered by the flap part).

Medoff shows a tongue part provided with a cut (8) into which the flap part is inserted to be fixed in the closed state for the purpose of being able to be refilled easily and quickly when emptied (page 1, column 1, lines 9-10). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify JP48 as taught by Medoff and include Medoff's similar device having a cut into which

Art Unit: 3653

the flap part is inserted to be fixed in the closed state for the purpose of being able to be refilled easily and quickly when emptied.

Response to Arguments

Regarding Fujiwara, the reference is now cited as WO 200189957 A1 (was US 2003/0164317 A1) with a 35 USC § 102(b) date of 29 November 2001.

Fujiwara does not describe the use of cellophane tape in detail, and does not indicate whether such cellophane tape is part of the package itself, as required in claim 1. Moreover, there is no suggestion that the use of the cellophane tape would provide a "recloseable flap" as required in claim 1, or whether it only works to initially secure the cap part 2. For example, there is no disclosure in Fujiwara that the cap-shaped cover part is reclosed once it is removed.

In response to applicant's argument above, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Therefore, the disclosed fastening member structure of Fujiwara suggests that the fastening member is used to fasten the recloseable flap in a closed state (as claimed).

Motivation was provided above for the combination of JP48 and Fujiwara.

Regarding Claims 16 and 17, MPEP § 2115, "Material Or Article Worked Upon Does Not Limit Apparatus Claims" states that "'Expressions relating the apparatus **to contents thereof** during an intended operation are of no significance in determining patentability of the apparatus claim.'" (emphasis added) In other words, the contents

Art Unit: 3653

used in an operation of an apparatus carry no patentable significance. Therefore, since Claims 16-17 only recite contents used in an operation of an apparatus ("heat-sensitive sheets"), the claims carry no patentable significance.

Regarding Medoff, see MPEP § 2115, "Material Or Article Worked Upon Does Not Limit Apparatus Claims".

Regarding Claim 15, note that the joining part (20g) of the recloseable flap member 20d/20e was cited in the previous Office Action. Therefore, the recloseable flap member 20d/20e was implicitly identified from Ishiduka's disclosure.

Examiner's reasons and arguments for using the disclosure of Fujiwara in combination with Ishiduka are above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3653


Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERALD W. MCCLAIN whose telephone number is (571)272-7803. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gerald W. McClain
Examiner
Art Unit 3653



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